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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,396	12/02/2003	Scott E. Brient	028/008	5624

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Roswell, GA 30075

EXAMINER	
MAHAFKEY, KELLY J	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/726,396	BRIENT, SCOTT E.	
	Examiner	Art Unit	
	Kelly Mahafkey	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-29 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-29 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 12/30/05, 2/8/05. 3/4/04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5, 7, 8, 12-14, 16, and 24-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12-14 of copending Application No. 11/336186 as originally filled. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '86 would produce the product of the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-5, 7-9, 12-14, 16, and 18-28, are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 41-46, 49, 51, 55, 56, 65, 70, and 74 of copending Application No. 10726388 as originally filled. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '88 would produce the product of the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

Claim 23 is objected to because of the following informalities: it is an exact duplicate of claim 22. This is believed to be a typo; appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "remote" in claim 10 is a relative term which renders the claim indefinite. The term "remote" is not defined by the claim, the specification does not

provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 5-8, 12, and 16-29 rejected under 35 U.S.C. 103(a) as being unpatentable over *Ketchup fries* (http://www.halfbakery.com/idea/ketchup_20fries November 29, 2000).

Ketchup fries teaches that it is desirable to impart a ketchup flavor into a French fry in order to eliminate the messiness that comes from dipping French fries and to improve driving safety (i.e. the safety factor when driving and consuming French fries with ketchup). Thus, *Ketchup fries* suggest putting traditional ketchup or powdered ketchup flavoring into a French fry. *Ketchup fries* teaches of putting ketchup flavor into fries, thus *Ketchup fries* teaches that the ketchup would be restricted within the French fires. Refer specifically to the portion as indicated as Sammmy, November 29, 2000 (*Ketchup fries* page 1, top left).

Ketchup fries does not explicitly recite the ketchup as traditional ketchup (i.e. a condiment), the amount of the condiment that is within the fry as recited in claims 5, 6,

8, 16, and 24-26 and to other condiments that can be included in the fry as recited in claims 18-23.

Regarding the ketchup as traditional ketchup (i.e. a condiment), *Ketchup fries* teaches that ketchup flavored powder does not have a desirable taste when compared to traditional ketchup (refer to the portion indicated as Centauri November 29, 2000 (*Ketchup fries* page 1, top right) and Human411 August 15, 2001 (*Ketchup fries* page 1, bottom and page 2, top)); that powdered flavor condiment substitution is not a reasonable option when adding a condiment or the resultant condiment flavor because the texture of the condiment is desirable (refer to the portion indicated as Dasjes September 26, 2001(*Ketchup fries* page 2, top)); and that condiments have been incorporated into the food products from which they are desired to be consumed with (refer to the portion indicated as Mcscotland March 30, 2001(*Ketchup fries* page 1, middle right)). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ketchup flavor in the French fry as taught by *Ketchup fries (Sammmy* (*Ketchup fries* page 1, top left)*)* as traditional ketchup (i.e. in condiment form) in view of *Ketchup fries* (Centauri, Human411, Dasjes, and/or Mcscotland (*Ketchup fries* pages 1-2)). One would have been motivated to do so in order to obtain a final product that had consumer desired organoleptic properties.

Regarding the amount of the condiment that is within the fry as recited in claims 5, 6, 8, 16, and 24-26 and other condiments that can be included in the fry as recited in claims 18-23, attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234,

the Court stated as follows: This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coactions or cooperative relationship between the selected ingredients, which produces a new, unexpected and useful function. In re Benjamin D. White, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Thus, specifically regarding the amount of the condiment that is within the fry as recited in claims 5, 6, 8, 16, and 24-26, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an amount of a specific condiment depending on the desired intensity of that condiment in the final product. To include such an amount would be incorporating a known ingredient for it's known function and would not impart a patentable distinction into the claims.

Thus, specifically regarding other condiments that can be included in the fry as recited in claims 18-23, it was known to one of ordinary skill in the art at the time the invention was made that ketchup, hot sauce, gravy, ranch dressing, cheese, and barbeque sauce were a known condiments for French fries. As evidenced by Wikipedia (Wikipedia, the free encyclopedia: http://en.wikipedia.org/wiki/French_fries), pages 4

and 5, (Accompaniments) ketchup, hot sauce, gravy, ranch dressing, cheese, and barbeque sauce were all known to accompany French fries. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute one art recognized functional equivalent (i.e. ketchup) for another (i.e. hot sauce, gravy, ranch dressing, cheese, or barbeque sauce) in the French fry as taught by *Ketchup fries* depending on desired flavor of the final product.

Examiner's Note: The interpretation of the *Ketchup fries* as suggesting ketchup-filled French fries may be further supported by the post-filing February 22, 2003 email addition submitted at the end of the article (the portion as indicated as Pericles February 22, 2003 (*Ketchup fries* page 3, top)), which states "I think it'd be a good idea to have ketchup-filled French fries. You get the exact amount of ketchup on each bite, and you won't have to take your attention off the road to dip while driving. I think this is rather easy to do". This demonstrates that the position of the Office sets forth a reasonable interpretation based upon the article commentary (Sammmy (*Ketchup fries* page 1, top left)).

Claims 2-4, 9-11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ketchup fries* as applied to claims 1, 5-8, 12, and 16-29 above, further in view of Ferrara Jr. (US 5337925).

Ketchup fries teaches of ketchup filled French fries as described above. *Ketchup fries* however is silent to the condiment as injected into the French fry through the outer potato shell as recited in claims 2 and 13, the French fry shell as having a defined

condiment hole as recited in claim 3, the French fry shell as having a defined condiment hole with a maximum width of less than 0.1 inch as recited in claim 4, a second condiment portion physically separated (i.e. remotely) from a first condiment portion as recited in claims 9-11, the condiment filled French fry as cooked as recited in claim 14, and the condiment filled French fry as uncooked as recited in claim 15.

Regarding the condiment as injected into the French fry through the outer potato shell as recited in claims 2 and 13 and the French fry shell as having a condiment receiving hole as recited in claim 3, Ferrara Jr. (Ferrara) teaches injection as an easy method of preparing foods with new and unusual textures and tastes. Ferrara teaches of injecting raw or cooked foods with condiments to provide a desired flavor. Refer specifically to column 1 lines 7-31, column 3 lines 42-52, and column 4 lines 4-19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the injection method as taught by Ferrara in order to easily insert the condiment into the French fry taught by *Ketchup fries*. One would have a reasonable expectation of success since Ferrara teaches of a method of easily preparing new and unusual foods and because *Ketchup fries* teaches of an unusual food but is silent in the method of preparing it. Note: The injection method of Ferrara with the invention of *Ketchup fries* would produce a French fry in which the condiment was injected through the outer potato shell of the French fry and a condiment receiving hole (i.e. a hole in which the condiment was injected through).

Regarding the French fry shell as having a defined condiment hole with a maximum width of less than 0.1 inch as recited in claim 4, as evidenced by Diary

(French Fry Diary 02, http://www.frenchfrydiary.blogspot.com) a well known French fry, the shoe string French fry is 0.25 inches thick. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the condiment hole in the French fry to be a width less than the standard width of well known French fries (i.e. less than 0.25 inches). It would have been further obvious to one of ordinary skill in the art at the time the invention was made for the condiment hole to be even smaller than the width of well known French fries depending on the condiment desired within the French fry and the pressure that it would exert upon the French fry (i.e. the condiment hole would have to be small enough so that when filled the French fry would not lose it's integral structure.)

Regarding a second condiment portion physically separated (i.e. remotely) from a first condiment portion as recited in claims 9-11, it was known in the art at the time the invention was made to eat French fires with condiments alone or in combination depending on the desired flavor characteristics in the final product. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the condiments together or in remote locations (i.e. in different condiment chambers) depending on the desired flavor characteristics in the final product.

Regarding the condiment filled French fry as cooked or uncooked as recited in claims 14 and 15 it was known at the time the invention was made to add flavoring to French fries uncooked (i.e. French fries made at home either from fresh potatoes or by cooking frozen fries found in grocery stores) and cooked (i.e. French fries consumed from a fast food restaurant). It would have been obvious to one of ordinary skill in the

art at the time the invention was made to fill the condiment into the French fry when the fry was cooked or uncooked depending on if the consumer desired a final product that was slower (i.e. that they were required to cook) or a faster product (i.e. a product that was completely prepared for them). Furthermore, it is noted that Ferrara teaches to inject condiments is a matter of preference that can be done before or after cooking of the food product (Column 1 lines 7-10).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Mahafkey
Examiner
Art Unit 1761

KEITH HENDRICKS
PRIMARY EXAMINER